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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/664,893  | 09/22/2003  | Karlheinz Hermann    | 0902-006            | 4265             |
| 7590  | 07/25/2005  |                      | EXAMINER            |                  |
| Steven M. duBois<br>Potomac Patent Group, PLLC<br>PO Box 855<br>McLean, VA 22101-0855 |             |                      | PRITCHETT, JOSHUA L |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2872                |                  |

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                     |                |
|------------------------------|---------------------|----------------|
| <b>Office Action Summary</b> | Application No.     | Applicant(s)   |
|                              | 10/664,893          | HERMANN ET AL. |
|                              | Examiner            | Art Unit       |
|                              | Joshua L. Pritchett | 2872           |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 June 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-14 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 22 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. \_\_\_\_\_  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) 5) Notice of Informal Patent Application (PTO-152)  
Paper No(s)/Mail Date. \_\_\_\_\_ 6) Other: \_\_\_\_\_

**DETAILED ACTION**

This action is in response to Amendment after non-final rejection filed June 10, 2005.

Claims 1 and 11-13 have been amended and claim 14 has been added as requested by the applicant.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 10-12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Spink (US 6,661,572).

Regarding claims 1 and 11, Spink discloses a microscopy system for observing an object positionable in an object plane (Fig. 1) comprising: at least one objective lens (10) arrangement for receiving an object side beam emanating from the object plane and for transforming the object side beam into an image side beam (Fig. 1); plural ocular systems (20a-b, 21a-b) arranged to enable each of the plural observers to observe the object by looking into a respective one of

the plural ocular systems (Figs. 5-7), wherein each ocular system comprises at least one ocular tube (Figs. 5-7) having at least one ocular for generating an image of the object plane from the image side beam, wherein each of the plural ocular systems further comprises at least one image projector (16) having a display for superimposing an image displayed by the display with the beam path of the ocular system such that the image of the object plane is perceived by the observer in superposition with the image of the display (col. 7 lines 10-21), and wherein at least one optical setting of a first ocular system of the plural ocular systems is adjustable independently of a corresponding optical setting of a second ocular system of the plural optical system (col. 7 lines 33-43; 17a-b, 18a-b); a controller (30-32) for generating the image displayed by the display of the first ocular system, wherein the controller is configured to generate the displayed image from a first input image based on the at least one optical setting of the first ocular system (col. 9 lines 49-53).

Regarding claims 2 and 14, Spink discloses the controller is configured to generate the displayed image from a second input image independently of the at least one optical setting, wherein the second input image is superimposed with the first input image. Controller (32) of Spink controls the prisms that generate the superimposed image viewed independently of the shutter controlled by controller (30).

Regarding claim 3, Spink discloses the first ocular system comprises a first camera (13a) and the second ocular system comprises a second camera (13b) and wherein the controller is configured to determine the at least one optical setting based on the comparison of an image detected by the first camera with an image detected by the second camera. Controller (30) of

Spink will determine the shutter location based on the superimposition of the image (col. 9 lines 49-53).

Regarding claims 4 and 12, Spink discloses the objective lens arrangement comprises an optical axis, wherein the ocular tube of the first ocular system is rotatable about the objective lens arrangement and the optical axis, wherein the at least one optical setting comprise a rotational position of the controller is configured to generate the displayed image from the first input image by rotating the first input image about an image rotation angle determined in dependence of the rotational position of the ocular tube (Figs. 5-7). Figs. 5-7 show that the ocular systems are rotatable about the objective lens. Controller (32) of Spink is also capable of rotating the displayed image (col. 9 lines 49-53).

Regarding claim 10, Spink discloses the plural ocular systems is a binocular system (Figs. 1 and 5-7).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spink (US 6,661,572).

Regarding claim 5, Spink teaches the invention as claimed but lacks specific reference to the detection of the angle between the ocular tube and the objective lens arrangement. Spink teaches that the controller (32) detects the position of the prisms and rotation of the prisms used to convey the image side beam to the ocular tube. One of ordinary skill in the art would find it obvious to have the controller also detect the angle between the objective lens and the ocular tube for the purpose rotating the prisms to the proper angle to allow the observe to see the image. Official Notice is taken. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the Spink invention include the detection of the angle between the ocular tube and the objective lens as is known in the art for the purpose of allowing the observer to view the image of the object.

Regarding claim 6, Spink teaches the invention as claimed but lacks reference to comparing the images of the two cameras. Spink teaches two cameras (13a-b) and the controller (32) detecting the position of the prisms and rotation of the prisms used to convey the image side beam to the ocular tube. One of ordinary skill in the art would find it obvious to compare the images of the two cameras to determine the angle of rotation of the ocular tube to the objective lens. Official Notice is taken. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the Spink invention include the detection of the rotation angle as is known in the art for the purpose of properly rotating the prisms to convey the image side beam to the ocular tube thus allowing the observer to view the image of the object.

Claims 7-9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spink (US 6,661,572) in view of Hoppl (US 5,002,376).

Regarding claims 7, 8 and 13, Spink teaches the invention as claimed including first and second cameras (13a-b) but lacks reference to the magnification of the plural ocular systems being independently adjustable. Hoppl teaches the magnification of two separate ocular systems are independently adjustable (abstract). Hoppl teaches a means for detecting the setting of the zoom components with respect to one another (col. 4 lines 19-60). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the Spink invention include the independently adjustable ocular magnification of Hoppl for the purpose of allowing the two observers to view two different images of the same object simultaneously.

Regarding claim 9, Spink in combination with Hoppl teaches the invention as claimed but lacks reference to comparing the images of the two cameras (13a-b). One of ordinary skill in the art would find it obvious to compare the images of the two cameras to determine the settings of the settings of the microscopy assembly. Official Notice is taken. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to compare the images of the first and second cameras of Spink as is known in the art for the purpose of determining the settings of the microscopy assembly.

***Response to Arguments***

Applicant's arguments filed June 10, 2005 have been fully considered but they are not persuasive.

On page 9 of Amendment applicant argues that the Spink reference fails to teach plural displays and image projectors. Spink does teach plural displays as shown in Figs. 5-7. The claim language does not require two distinct image projectors. The claim states that each system has a projector but does not require that each system have a distinct projector. The examiner interprets the claim language to allow for the possibility that one projector can serve both ocular systems, therefore the Spink reference anticipates the claim limitations. If the applicant wishes the claim to require the use of separate image projectors the examiner suggests the use of language such as, “a first” and “a second” or “distinct” to better convey the intentions of the applicant.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP *[Signature]*



DREW A. DUNN  
SUPERVISORY PATENT EXAMINER